

HT-00-002



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November 4, 2004

To: Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Attn: Art Unit 2652 - David Donald Davis

From: George O. Saile, Reg. No. 19,572

28 Davis Avenue

Poughkeepsie, N. Y., 12603

Subject: | Serial No.: 09/822,491 04/02/01 |

Chen-Jung Chien et al.

A WAY TO IMPROVE HARD BIAS  
PROPERTIES FOR AN ABUTTED  
JUNCTION GMR RECORDING HEAD

| \_ Art Group: 2652 David Donald Davis \_ |

#### RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Restriction or Election Requirement in the Office Action dated 10/21/04. In that Office Action, restriction was required to one of two stated

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 12, 2004.

Stephen B. Ackerman, Reg.# 37761

Signature/Date

SBH 11/12/04

Inventions under 35 U.S.C. 121. The Inventions stated are Group I - Claims 1-7 to a process, classified in Class 29, subclass 603.01 and Group II - Claims 8-14 to a spin-valve abutted junction GMR sensor element, classified in Class 360, subclass 324.12.

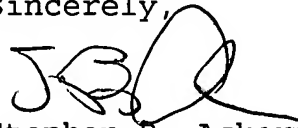
Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-7 drawn to a process classified in Class 29, subclass 603.01. This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action. The Examiner gives the reason for the distinctness of the two inventions as (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). However, upon reading the product Claims against the process Claims one can readily see that the product Claims are directed to "a spin-valve type abutted junction GMR sensor element with a thinner hard magnetic longitudinal bias layer having significantly improved magnetic properties in the junction region" and the process Claims are directed to "a method for forming a spin-valve type abutted junction GMR sensor element with a thinner hard

magnetic longitudinal bias layer having significantly improved magnetic properties in the junction region", it is necessary to obtain claims in both the product and method claim language. The method Claims necessarily use the product and vice versa. The field of search must necessarily cover both the method class/subclass 29/603.01 and products class 360/324.12 in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the product as claimed, the spin-valve type abutted junction GMR, can be made by sputtering the spin-valve GMR instead of etching", is very speculative and really has nothing to do with the Claims as presented in this Patent Application. Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement and the Allowance of the present Patent Application is requested.

Sincerely,

A handwritten signature in black ink, appearing to read 'JB', with a large, stylized flourish extending from the end of the signature.

Stephen B. Ackerman, Reg.# 37761